

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: September 3, 2003

Paper No. 13

BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tierra Products AB, by assignment from Anders
Andersson¹

Serial No. 75/831,238

Richard M. LaBarge of Marshall, Gerstein & Borun for
applicant.

Amy Gearin, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Hanak, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant filed on October 21, 1999 an application to
register on the Principal Register the mark shown below

¹ The records of the Assignment Branch of the USPTO indicate that this application was assigned from Anders Andersson (a Swedish citizen) to Tierra Products AB (a corporation of Sweden). See Reel 2436, Frame 0680. (We note that Anders Andersson had, on September 26, 1999, filed application Serial No. 75/649,268 for the mark TIERRA (in typed form) for the same identified goods in International Classes 18 and 25, based on the original applicant's assertion of a bona fide intention to use as well as Section 44 of the Trademark Act, 15 U.S.C. §1126. That



for goods amended to read: "rucksacks and all-purpose bags sold through sporting goods stores" in International Class 18, and "clothing, namely, shirts, pants, shorts, jackets, caps, gloves, gaiters, sweaters, and underwear for children, women, and men" in International Class 25. The application is based on the original applicant's assertion of a bona fide intention to use the mark. Upon requirement of the Examining Attorney, applicant included the following translation of the mark: "'Tierra' is Spanish for earth, land, or soil."

Registration was refused as to both classes of goods under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered mark TIERRA for "luggage" in International Class 18² as to be likely to cause confusion, mistake or deception.

application was also assigned to Tierra Products AB; and action on it is currently suspended in Law Office 115.)

² Registration No. 2,462,350, issued June 19, 2001 to Skyway Luggage Company. The registration includes the following statement: "'Tierra' is 'earth,' 'world,' 'land,' 'ground' or 'soil.'"

When the refusal was made final, applicant appealed as to the Class 25 goods only.³ Briefs have been filed, but applicant did not request an oral hearing.

Our determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to a consideration of the marks, applicant's mark and the registered mark are virtually identical. The word TIERRA is the cited registrant's mark and it is the dominant feature of applicant's mark. See *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749

³ Thus, applicant has abandoned the application as to the Class 18 goods. See Section 12(b) of the Trademark Act, 15 U.S.C. §1062(b). See also, TMEP §718 (3d ed. 2002).

(Fed. Cir. 1985). While applicant's mark shows the word in stylized lettering and includes a design of an outdoorsman's ax or pick, this does not sufficiently distinguish the marks because purchasers are unlikely to remember the specific differences, focusing more on the word TIERRA. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Applicant's mark and the registered mark are identical in sound and connotation, and are very similar in appearance and commercial impression.

The question then becomes whether the Examining Attorney has demonstrated that various items of clothing (applicant's goods) and luggage (registrant's goods) are related to such a degree that consumers would expect clothing and luggage sold under the respective marks to emanate from a single source.

The Examining Attorney argues that the goods are "highly related"; and that she "must also consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's goods or services under Section 2(d)." (Brief, pp. 2-3.)

The only evidence made of record by the Examining Attorney consists of 15 third-party registrations, which are based on use in commerce, and which include both clothing and luggage in the identifications of goods, to show that "luggage and clothing emanate from a single source." (Final Office action, p. 2.)

Applicant argues that the Examining Attorney has not established that these goods are sufficiently related to result in a likelihood of confusion; that the mere registration of a few marks for both clothing and luggage does not provide a reliable basis for concluding that ordinary purchasers expect to see luggage manufacturers using their marks for clothing; that, in fact, applicant's evidence shows the contrary, i.e., ordinary purchasers do not expect that luggage brands are normally used on clothing; that luggage and clothing are sold in different channels of trade; and that registrant's mark is not a famous mark.

Applicant's evidence⁴ consists of printouts of pages from the web sites of Samsonite Inc. (Exhibit A) and the

⁴ Applicant submitted evidence (Exhibits A-F) for the first time with its brief on appeal. Normally, material submitted for the first time with applicant's brief would be excluded as untimely submitted. See Trademark Rule 2.142(d), and TBMP §1207.01 (2d ed. June 2003). However, in this case, the Examining Attorney did not object thereto, and, in fact, she discussed the evidence treating it as if it was of record. See TBMP §1207.03 (2d ed.

cited registrant, Skyway Luggage Company, (Exhibit B) showing that neither luggage company offers any clothing of any type (although Samsonite offers items such as luggage locks, toiletry kits, umbrellas)⁵; a printout from a web site named "reshare.com" with a section on the luggage industry beginning with the following statement: "The luggage industry consists only of manufacturers and retailers. 70% of all products are sold through specialty stores and 30% through department stores." (Exhibit C); and printouts of pages from the web sites of J.C. Penney, Sears and Macy's (Exhibits D-F) showing that luggage sold in department stores is not offered in the clothing department.

June 2003). Accordingly, the Board considers applicant's evidence stipulated into the record.

⁵ Applicant also made reference in its brief to Samsonite Inc.'s intent-to-use applications for clothing items, all of which Samsonite abandoned, contending that this shows that luggage companies do not make clothing and purchasers do not expect to find luggage trademarks on clothing. The Examining Attorney argues that these Samsonite applications (as well as applicant's own involved application) lend credence to her position that the goods are related. Neither applicant nor the Examining Attorney submitted copies of the applications into the record.

The Board finds this information to be neutral, and not supportive of either position. First, it is merely a statement with no supporting evidence. Second, even if proper copies of Samsonite's applications had been submitted (by either applicant or the Examining Attorney), third-party intent-to-use applications are probative only of the filing dates. We find that this neither supports nor contravenes any finding on the relatedness of the involved goods.

Having carefully reviewed the evidence, we conclude that the Examining Attorney has not made a prima facie showing that these goods are related.

The third-party registrations submitted by the Examining Attorney are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to suggest that such goods are of a type which may emanate from the same source. See *In re Digirad Corp.*, 45 USPQ2d 1841, 1844 (TTAB 1998); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

The problem in this case is that the Examining Attorney must establish the relatedness of the goods, and while we can consider the third-party registrations to be of some limited probative value on this issue, there is no further evidence to support the Examining Attorney's position (for example, advertisements showing both clothing and luggage offered for sale, and catalog excerpts showing that these goods are offered for sale in the same catalog). Applicant, however, has submitted evidence to show the

goods are not related and do not move in the same channels of trade.

The Examining Attorney also relied on the decision of the Board in the case of Jantzen, Inc. v. Evans-Aristocrat Industries, Inc., 147 USPQ 531 (TTAB 1965), and she argues that the Board has found "baggage, portfolios and pocketbooks" to be "closely related to swim suits and a line of apparel for men, women and children." (Brief, p. 5.) However, in that inter partes case, the Board explained and held as follows (147 USPQ at 532):

In view of the extensive advertising and the amount of sales of 'JANTZEN' products [about \$51,000,000 annually], such mark must have made a substantial impact on the purchasing public and, in addition, the record establishes that petitioner has used this mark not only on beach and sportswear but also on coordinates thereto such as costume jewelry, beach towels and beach bags. Since pocketbooks and related items of luggage would normally be considered as accessories or coordinates to beach or sportswear, the goods involved under these marks must be considered as closely related in kind.

However, this statement by the Board clearly relates to luggage which is related to pocketbooks, not to a general relationship between luggage on the one hand, and beachwear or sportswear on the other hand. Although pocketbooks (and other non-clothing items, such as jewelry)

have been viewed as accessories to clothing (perhaps because these items are frequently matched to clothing to form an outfit), there is no evidence in the record now before us that people match their luggage to their clothing.

Thus, on this ex parte record, we are constrained to find that the Examining Attorney has not established a likelihood of confusion. See *In re Digirad Corp.*, supra; and *In re Albert Trostel & Sons Co.*, supra.

Applicant's argument that it does not believe the cited mark is famous or well known is misplaced in the context of this ex parte appeal. Applicant's belief that the registered mark is not famous is not sufficient to make this du Pont factor one which is to be considered herein, and the Examining Attorney has provided no evidence thereon. Thus, the du Pont factor of fame of the prior mark is irrelevant because there is no evidence thereon. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Decision: The refusal to register the Class 25 goods under Section 2(d) is reversed. The application stands abandoned as to the Class 18 goods because the refusal to register with regard thereto was not appealed by applicant,

Ser. No. 75/831238

and the application will proceed to publication for the
Class 25 goods only.